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Atty. Dkt. No. 049411-0266

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hongxing TANG et al.

Title: On-Chip Magnetic Force Actuation of
Microcantilevers by On-Chip Coils

Appl. No.: 10/815,517

Filing Date: 4/1/2004

Examiner: Rose Mary MILLER

Art Unit: 2856

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the election of species requirement set forth in the Office Action mailed December 9, 2005, Applicants hereby elect species 3 with traverse. Applicants submit that at least claims 8 and 27 correspond to species 3. Claims 1, 11-12, 21, 24, 33-35 and 43 have been indicated to be generic. Thus, applicants request that claims 1, 8, 11-12, 21, 24, 27, 33-35 and 43 be examined on the merits.

The traverse is on the ground that the species were improperly delineated. The election of species requirement is improper because it violates the rule set forth in MPEP § 806.04(f). MPEP § 806.04(f) states that "claims to be restricted to different species must recite mutually exclusive characteristics of such species." However, this condition is not met in the present application.

For example, the subject matter of species 3 (substantially co-planar cantilever, coil and magnetic element) is not mutually exclusive from the subject matter of species 1, 4, 5 and

6. In other words, a substantially co-planar cantilever, coil and magnetic element of species 3 is not mutually exclusive from a planar loop coil of species 1 or from a magnetic element comprising an array of nanomagnets of species 4, or from coupling cantilevers to a spring of species 5 or from an array of cantilevers, coils and magnetic elements of species 6 (i.e., the array of species 6 may comprise an array of substantially co-planar cantilevers, coils and magnetic elements).

Thus, claims 2, 3, 7, 8-10, 13-20, 22, 23, 25, 26, 28, 32, 36-42 and 44-45 which correspond to species 1, 4, 5 and 6 do not satisfy the condition in MPEP § 806.04(f) that for claims to be restricted to different species, the claims must recite mutually exclusive characteristics of such species. Applicants respectfully request that claims 2, 3, 7, 8-10, 13-20, 22, 23, 25, 26, 28, 32, 36-42 and 44-45 should also be examined on the merits.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 1/3/05

By Leon Radomsky

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